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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,469	03/21/2006	Atsushi Ogawa	090358	8944
23850 7590 06/21/2011 KRATZ, QUINTOS & HANSON, LLP 1420 K Street, N.W. 4th Floor WASHINGTON, DC 20005			EXAMINER OU, JING RUI	
			ART UNIT 3773	PAPER NUMBER
			MAIL DATE 06/21/2011	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/541,469

**Applicant(s)**

OGAWA ET AL.

**Examiner**

JING RUI OU

**Art Unit**

3773

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 April 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 5, 8-10 and 12-14 is/are pending in the application.
- 4a) Of the above claim(s) 8-10 and 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 12 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-945)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is responsive to the amendment filed on 04/14/2011. Claims 1-3, 5, 8-10, and 12-14 are pending. Claim 1 is independent. Claims 4, 6, 7, and 11 have been cancelled. Claims 8-10 and 13 are withdrawn.

#### ***Claim Objections***

2. Claim 3 is objected to because of the following informalities: In line 2 of claim 3, the phrase "the the main coil body" should be corrected to "the main coil body."

Claim 5 is objected to because of the following informalities: Claim 5 cannot depend on claim 4 since claim 4 has been cancelled.

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 2, 5, 12, and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Martinez (US Pub. No. 2004/0098028).

In regard to claims 1, 2, 5, 12, and 14, Martinez discloses an embolus forming in-vivo indwelling device (10) comprising a coil separating member (16) and a coil main body (13) having flexibility and a stretch suppressing member (12) which is provided on

an inner periphery of the coil main body and which is made of a polyvinyl alcohol polymer (Para. [0023]); wherein the stretch suppressing member is provided on the inner periphery of the coil main body (Figs. 1-2), the stretch suppressing member has a smaller diameter than the coil diameter of the coil main body (Figs. 1-2), and the stretch suppressing member enters space between adjacent wire turns of the coil main body as a result of the swelling (Figs. 3-4); wherein the coil main body has a coil diameter of 0.25 mm (Para.[0039]); wherein the stretch suppressing member has a rod-like shape and is provide in the coil main body so as to pass through the coil main body and extend in the coil axial direction of the coil main body (Para. [0022], a cylindrical shape can be considered as a rod-like shape since a rod can be cylindrical); Wherein the diameter of the stretch suppressing member is smaller than the inner diameter of the coil main body by about 1 to 50% in a dry state (Figs. 1-2 and Para. [0039]); wherein the coil main body has space between each turn before swelling (Figs. 1-2); wherein the coil separating member is partially provided inside the coil body in a state that a distal end of the coil separating member is in contact with a proximal end of the stretch suppressing member (Figs. 2 and 4).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martinez (US Pub. No. 2004/0098028) as applied to claim 3 above, and further in view of Wallace et al (US Pub. No.: 2002/0151926).

In regard to Claim 3, Martinez discloses all the limitations of the claim as taught above but does not appear to disclose that the wire constituting the coil main body has a diameter of 10 to 120  $\mu\text{m}$ , a coil length of 2 to 500 mm and a number of turns of 1 to 100 per unit length (1mm). However, Wallace et al discloses a vaso-occlusive coil comprising a wire that constitutes the coil main body has a diameter of 12.7 mm to

152.4 mm, a coil length of 24 to 400 mm and a number of turns of 1 to 7.5 per unit length (1mm) (Para.[0030]). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the coil of Martinez to include the dimensions of the coil with a wire that constitutes the coil main body has a diameter of 12.7 mm to 152.4 mm, a coil length of 24 to 400 mm and a number of turns of 1 to 7.5 per unit length (1mm) as taught by Wallace et al, since it has been held that that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

#### ***Response to Arguments***

6. Applicant's arguments filed 04/14/2011 have been fully considered but they are not persuasive. The allegation on page 10 of the remarks that "Martinez does not disclose the rod-like shape limitation" is incorrect. Martinez clearly discloses that element 12 can be formed as a cylinder (Para. [0022], a cylindrical shape can be considered as a rod-like shape since a rod can be cylindrical).

#### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JING RUI OU whose telephone number is (571)270-5036. The examiner can normally be reached on 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CORRINE MCDERMOTT can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/541,469

Page 7

Art Unit: 3773

/J. O./

Examiner, Art Unit 3773

06/15/2011

/Darwin P. Erezio/

Primary Examiner, Art Unit 3773